

REMARKS

Claims 1-26, 28-33, and 35-47 remain pending in this application.

In the Office Action,¹ the Examiner rejected claims 22, 23, 25, 26, 28-30, 32, 33, 35, and 44-47 under 35 U.S.C. § 103(a) as being unpatentable over Chern et al. (U.S. Patent No. 6,381,465) in view of Angles et al. (U.S. Patent No. 5,933,811); rejected claims 1, 2, 5, 8-11, 13, 14, 16, 17, 21, 36, and 38-43 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee et al. (U.S. Patent No. 6,829,475) and in further view of Angles; rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee, Angles, and Atsmon et al. (U.S. Patent No. 6,607,136); rejected claims 4 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee, Angles, and Maxwell (U.S. Patent No. 6,470,181); rejected claims 6, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee, Angles, and Bezos et al. (U.S. Patent No. 6,029,141); rejected claims 7, 12, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee, Angles and Matsumoto et al. (U.S. Patent No. 6,484,946); and rejected claims 24 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Angles and in further view of Maxwell.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

I. REJECTION OF CLAIMS 22, 23, 25, 26, 28-30, 32, 33, 35, AND 44-47

Applicant respectfully traverses the rejection of claims 22, 23, 25, 26, 28-30, 32, 33, 35, and 44-47 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Angles because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, the prior art (taken separately or in combination) must teach or suggest all of the claim elements. See MPEP § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2. In this application, a *prima facie* case of obviousness has not been established for at least the reason that the prior art fails to teach or suggest each and every element of the claims.

Claim 22 recites a method for wireless device advertising including, among other steps, “paying a fee to the wireless advertising service, wherein a portion of the fee goes to a user of the registered wireless device as remuneration once the user has accepted a predetermined **volume of bytes** of advertising messages sent to the registered wireless device” (emphasis added). Chern and Angles, individually or in combination, do not disclose or suggest at least this step of claim 22.

In the Office Action, the Examiner admits Chern does not teach “remunerating users once the user has accepted a predetermined volume of bytes of the advertising messages” or that “a portion of the fee paid for said advertising service goes to the user.” See Office Action, page 3.

Moreover, Angles does not compensate for the deficiencies of Chern. By contrast, Angles discloses that “the system of the present invention can pay an Internet provider based on the number of advertisements viewed by its consumers. The Internet providers can then use this advertising revenue to reduce consumer access fees.” See col. 4, lines 43-47. In the alternative, Angles teaches paying “a consumer for viewing advertisements by crediting a consumer’s Internet provider account.” See col. 16, lines 35-37. Paying an Internet provider based on the number of advertisements viewed and using that revenue to reduce access fees, or crediting a consumer’s Internet provider account, does not constitute or suggest remunerating a user “once the user has accepted a predetermined **volume of bytes** of advertising messages sent to the registered wireless device,” as required by claim 22 (emphasis added).

In the Office Action, the Examiner states that Angles teaches “paying registered users for accepting advertisement messages transmitted to registered user terminals each time (predetermined number) the registered users view an advertisement.” See page 14. The Examiner then contends because “each advertisement message (electronic file) consists of a certain volume of bytes, said number (predetermined) of advertisements viewed at (transmitted to) the user terminal indicates a predetermined volume of bytes of advertising messages” (emphasis omitted). See id. However, the Examiner has not cited to any portion of Angles that teaches or suggest remunerating a user “once the user has accepted a predetermined **volume of bytes** of advertising messages sent to the registered wireless device,” as required by claim 22 (emphasis added).

Specifically, Angles teaches paying an “Internet provider based on the number of advertisements viewed by its consumers.” See col. 4, lines 43-45; see also col. 16, lines 31-37. First, Angles teaches that it is the Internet provider that is compensated, and not “registered users,” as required by claim 22. Second, Angles does not teach or suggest remunerating a user “once the user has accepted a predetermined **volume of bytes** of advertising messages sent to the registered wireless device,” as required by claim 22 (emphasis added).

The Examiner appears to assert that advertisements consist of bytes, and if payment is determined based on one advertisement being provided, then the payment is based on the number of bytes. That is, the Examiner appears to assert that a predetermined volume bytes is the same as a number of advertisement messages. Applicants disagree. Nothing in Angles teaches or suggests remunerating a user “once the user has accepted a predetermined **volume of bytes** of advertising messages sent to the registered wireless device,” as required by claim 22 (emphasis added). At most, Angles teaches paying an Internet provider based on the **number of advertisements** viewed by its consumers. Nothing in the prior art suggests a relationship between a number of advertisements and a volume of bytes. In particular, the Angles system does not consider or use the volume of bytes accepted by a user to determine the payment.

For at least the above reasons, Angles does not compensate for the deficiencies of Chern. Accordingly, Chern and Angles, whether taken alone or in combination, do not disclose or suggest each and every element of claim 22. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claim 22 under 35 U.S.C. § 103(a).

Independent claim 29, while of a different scope from claim 22, includes recitations similar to those discussed above with regard to claim 22. Accordingly, Chern and Angles, alone or in combination, also do not disclose or suggest all elements of claim 29 and fail to establish a *prima facie* case of obviousness. Therefore, the Examiner should also withdraw the rejection of claim 29 and the rejection of dependent claims 23, 25, 26, 28, 30, 32, 33, 35, and 44-47, which depend from one of allowable independent claims 22 and 29.

II. REJECTION OF CLAIMS 1, 2, 5, 8-11, 13, 14, 16, 17, 21, AND 36-43

Applicant respectfully traverses the rejection of claims 1, 2, 5, 8-11, 13, 14, 16, 17, 21, and 36-43 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee and in further view of Angles.

Claim 1 recites a method of wireless device advertising including, among other steps, “remunerating a user of the registered wireless device once the user has accepted a predetermined volume of bytes of advertising messages sent to the registered wireless device.” As discussed above, Chern and Angles, whether taken alone or in combination, do not disclose or suggest at least this step. Furthermore, Lee does not compensate for the above-described deficiencies of Chern and Angles.

In the Office Action, the Examiner alleges Lee “teaches a method and system for transmitting advertising messages to wireless devices wherein prior to receiving said advertising messages, a user has to register his/her wireless device.” See Office Action, page 6. Even assuming the Examiner’s allegations are correct, which Applicant does not concede, Lee does not disclose or suggest at least “remunerating a user of the

registered wireless device once the user has accepted a predetermined volume of bytes of advertising messages sent to the registered wireless device,” as recited in claim 1.

For at least the above reasons, Chern, Lee, and Angles, whether taken alone or in combination, do not disclose or suggest each and every element of claim 1.

Accordingly, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Independent claims 11 and 17, while of a different scope from claim 1 and each other, include recitations similar to those discussed above with regard to claim 1.

Accordingly, Chern, Lee, and Angles, alone or in combination, also do not disclose or suggest each and every element of claims 11 and 17. Accordingly, the Examiner should also withdraw the rejection of claims 11 and 17 under 35 U.S.C. § 103(a) and the rejection of dependent claims 2, 5, 8-10, 13, 14, 16, 21, and 36-43, which depend from one of allowable independent claims 11 and 17.

III. REJECTION OF CLAIM 3

Applicant respectfully traverses the rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee, Angles, and Atsmon. Claim 3 depends from allowable claim 1, which includes a step of “remunerating a user of the registered wireless device once the user has accepted a predetermined volume of bytes of advertising messages sent to the registered wireless device.” As discussed above, Chern, Lee, and Angles, whether taken alone or in combination, do not disclose or suggest at least this step. Furthermore, Atsmon does not compensate for the above-described deficiencies of Chern, Lee, and Angles.

The Examiner alleges Atsmon “teaches a method for interacting with a broadcast media (TV or PC) to receiver coupons and sales special offers, wherein users receive incentive points as a reward for watching [the] advertisement.” See Office Action at page 10. Even assuming the Examiner’s allegations are correct, which Applicant does not concede, Atsmon does not disclose or suggest at least “remunerating a user of the registered wireless device once the user has accepted a predetermined volume of bytes of advertising messages sent to the registered wireless device,” as recited in claim 1. For at least the above reasons, Chern, Lee, Angles, and Atsmon, whether taken alone or in combination, do not disclose or suggest each and every element of claim 3. Accordingly, a *prima facie* case of obviousness has not been established. Therefore, the Examiner should withdraw the rejection of claim 3 under 35 U.S.C. § 103(a).

IV. REJECTION OF CLAIMS 4 AND 19

Applicant respectfully traverses the rejection of claims 4 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee, Angles, and Maxwell. Claims 4 and 19 respectively depend from allowable claims 1 and 17. As discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Maxwell does not compensate for the above-described deficiencies of Chern, Lee, and Angles.

The Examiner alleges Maxwell “teaches a method and system for delivery of advertising messages to cell phones, wherein an advertiser pays a portion of the airtime cost of a call originated by a mobile subscriber after that subscriber has listened to a recorded advertisement.” See Office Action at page 11. Even assuming the Examiner’s

allegations are correct, which Applicant does not concede, Maxwell does not compensate for the deficiencies of Chern, Lee, and Angles discussed above. Accordingly, Chern, Lee, Angles, and Maxwell, whether taken alone or in combination, do not disclose or suggest claims all elements required by claims 4 and 19. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claims 4 and 19 under 35 U.S.C. § 103(a).

V. REJECTION OF CLAIMS 6, 15, AND 20

Applicant respectfully traverses the rejection of claims 6, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee, Angles, and Bezos. Claims 6 and 15, and claim 20 respectively depend from allowable claims 1 and 17. As discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Bezos does not compensate for the above-described deficiencies of Chern, Lee, and Angles. The Examiner alleges Bezos “teaches a method and system for an internet-based customer referral system, wherein registered users receive commissions for referring other users to [a] merchant’s site.” See Office Action at page 12. Even assuming the Examiner’s allegations are correct, which Applicant does not concede, Bezos does not compensate for the deficiencies of Chern, Lee, and Angles discussed above. Accordingly, Chern, Lee, Angles, and Bezos, whether taken alone or in combination, do not disclose or suggest all elements required by claims 6 and 15, and claim 20. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claims 6, 15, and 20 under 35 U.S.C. § 103(a).

VI. REJECTION OF CLAIMS 7, 12, AND 18

Applicant respectfully traverses the rejection of claims 7, 12, and 18 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Lee, Angles and Matsumoto. Claims 7 and 12, and claim 18 respectively depend from allowable claims 1 and 17. As discussed above, Chern, Lee, and Angles do not disclose or suggest all of the elements of claims 1 and 17. Furthermore, Matsumoto does not compensate for the above-described deficiencies of Chern, Lee, and Angles. The Examiner alleges Matsumoto "teaches a method for accessing and displaying information related to [an] electronic money transaction, wherein a user is able to ... [access] his account to review confidential information, including points accumulated and redeemed at participating merchants." See Office Action at page 12. Even assuming the Examiner's allegations are correct, which Applicant does not concede, Matsumoto does not compensate for the deficiencies of Chern, Lee, and Angles discussed above. Accordingly, Chern, Lee, Angles, and Matsumoto, whether taken alone or in combination, do not disclose or suggest all elements required by claims 7 and 12, and claim 18. Since a *prima facie* case of obviousness has not been established, the Examiner should withdraw the rejection of claims 7, 12, and 18 under 35 U.S.C. § 103(a).

VII. REJECTION OF CLAIMS 24 AND 31

Applicant respectfully traverses the rejection of claims 24 and 31 under 35 U.S.C. § 103(a) as being unpatentable over Chern in view of Angles and in further view of Maxwell. Claims 24 and 31 respectively depend from allowable claims 22 and 29, the elements of which are neither disclosed nor suggested by Chern and Angles. Further,

as noted above in the discussion of claims 4 and 19, Maxwell also does not make up for the deficiencies of Chern and Angles. Accordingly, Chern, Angles, and Maxwell, whether taken alone or in combination, do not disclose or suggest all of the elements required by claims 24 and 31. Therefore, a *prima facie* case of obviousness has not been established and the Examiner should withdraw the rejection of claims 24 and 31 under 35 U.S.C. § 103(a).

CONCLUSION

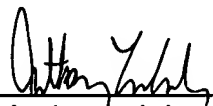
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 13, 2007

By: 

Anthony J. Lombardi
Reg. No. 53,232